

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/789,914
Filing Date: February 27, 2004
Applicant: Hosomi et al.
Group Art Unit: 1714
Examiner: Kriellion Sanders
Title: Resin Composition, Prepeg, Laminate and
Semiconductor Package
Attorney Docket: 2497-000002/CP

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

SECOND AMENDMENT UNDER 37 CFR 1.312

Sir:

Applicants attorney makes of record the Applicants claim to priority under 35 USC §120 of PCT/JP02/08845, filed August 30, 2002, which claims priority of Japanese application no. 2001-264385, filed August 31, 2001. Correction of this Patent Office error is respectfully requested.

Background

Applicants entered the national phase by filing the above-identified application on February 27, 2004 (before the expiration of the 30-month time limit) as a continuation-in-part of PCT/JP02/08845. Applicants use of the Utility Application Transmittal (Form PTO/SB/05) rather than the Transmittal Letter To The United States Designated/Elected

Office Concerning A Submission Under 35 U.S.C. 371 (Form PTO-1390) was appropriate in view of the fact that the present application was filed as a CIP of International Application No. PCT/JP02/08845. The Application Data Sheet which accompanied the subject application clearly identified the international filing date (30 August 2002) of the international application (PCT/JP02/08845) designating the United States of America and also claimed priority of the Japanese application (2001-264385), filed on August 31, 2001.

Additionally, on July 27, 2004, Applicants filed the Oath/Declaration (Response to Missing Parts dated May 27, 2004) also clearly referencing the §120 priority to the PCT application and §119 priority to the Japan application.

On January 22, 2007, Applicants became aware of the priority discrepancy upon receipt of the office action dated January 19, 2007, in which the Examiner stated that "Acknowledgement is made of applicant's claim for priority under 35 USC 119(a-d) based upon an application filed in Japan on 8/31/2002. A claim for priority under 35 USC 119(a-d) cannot be based on said application, since the United States application was filed more than twelve months thereafter." Applicants submit that the Patent Office had somehow failed to notice the §120 priority claim, but was indeed acknowledging the §119 priority claim.

In Applicants response dated April 18, 2007 to the Office Action dated January 19, 2007, Applicants again made of record the §120 and §119 priority claims described above.

In August 2007, Applicants attorneys office contacted the US Patent Office Examining Attorney to raise the priority issue in view of the fact that a Notice of Allowance had issued. The Examining Attorney indicated that she would investigate the matter and

return and our call; but did not. Several additional attempts to contact the Examining Attorney were made. None of our telephone calls have been returned to date.

Summary

Applicants have made diligent effort to have the Office Records corrected. The US Patent Office has failed to acknowledge the evidence presented regarding the claim of priority and/or our efforts. Applicants submit that in view of the evidence previously presented and reiterated above that a priority claim under 35 USC §120 to the International Application No. PCT/JP02/08845 filed August 30, 2002, which claims priority under 35 USC § 119 of the earlier filing date of August 31, 2001 of JP 2001-264385, has been sufficiently established, now requests immediately acknowledgement of the Patent Office error and correction of the Office records.

If it is believed that personal communication will expedite this matter, please telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: October 4, 2007

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